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10/694,868	10/29/2003	Yohichiroh Matsuno	244714US2	5692
22850	7590	05/26/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			COPPOLA, JACOB C	
			ART UNIT	PAPER NUMBER
			3621	
			NOTIFICATION DATE	DELIVERY MODE
			05/26/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

<b>Application No.</b> 10/694,868	<b>Applicant(s)</b> MATSUNO ET AL.	
<b>Examiner</b> JACOB C. COPPOLA	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 02 March 2009.
- 2a)  This action is **FINAL**.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-21 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All   b)  Some \*   c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

### *Acknowledgements*

1. This action is in reply to the remarks/arguments and claim amendments filed on 02 March 2009 (“09 Mar Remarks” and “09 Mar Amendments,” respectively).
2. Claims 1-21 are currently pending and have been examined.
3. This Office Action is given Paper No. 20090518. This Paper No. is for reference purposes only.

### *Restrictions*

4. The Examiner has determined that none of the pending independent claims are patentably distinct from one another. Accordingly, the Restriction Requirement issued in the Office action mailed 16 October 2008 is hereby withdrawn.

### *Claim Rejections - 35 USC § 101*

5. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-20 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Art Unit: 3621

***Regarding Claims 1-10***

7. These claims recite “[a] service providing apparatus... comprising: an authentication request accepting section... and an authentication information updating section”. In their broadest reasonable interpretation and in light of the specification, the two components recited above can be interpreted as computer programs only.

8. Additionally, the Examiner notes that using the broadest reasonable interpretation of “processor,” as noted below, the claimed processor is interpreted as a computer program only.

9. Therefore, these claims recite computer programs only. “Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical ‘things.’ They are neither computer components nor statutory processes, as they are not ‘acts’ being performed.” MPEP §2106.01 I. Because the claims recite only abstractions that are neither “things” nor “acts,” the claims are not within one of the four statutory classes of invention<sup>1</sup>.

Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101.

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<sup>1</sup> 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures, and composition of matter. The latter three categories define “things” (or products) while the first category defines “actions” (*i.e.*, inventions that consist of a series of steps or acts to be performed).

Art Unit: 3621

***Regarding Claims 11-20***

10. Based on Supreme Court precedent<sup>2</sup> and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) (en banc).

11. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

12. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

13. In this particular case, the claims fail prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine. As noted above, a processor may be interpreted as a computer program only, and therefore a processor may be interpreted as not being a machine. Additionally, the claims fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

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<sup>2</sup> See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Art Unit: 3621

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

14. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claim 21 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

***Regarding Claim 21***

16. This claim recites “[a] memory which stores a program, which when executed by a service providing apparatus, causes....” This claim is indefinite because it is unclear whether the “executed” is directed to the memory or the program.

17. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Art Unit: 3621

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-21, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Ooho et al. (U.S. 2003/0028454 A1) (“Ooho”), in view of Aldis et al. (U.S. 2004/0039916 A1) (“Aldis”), and in further view of Tohyama (U.S. 2002/10091645 A1) (“Tohyama”).

***Regarding Claim 1***

20. Ooho discloses an authentication information managing section (“license information management unit **48a**”) configured to manage authentication information related to the services (“license information” in the “license information table **421a**”), the authentication information having a term of validity (¶ 0068; and fig. 4 with associated text); a processor (“license information management unit **48a**”) configured to accept an extension request to extend the term of validity of the authentication information, judge whether an authentication information record was created by the service providing apparatus by referring to an identifier included in the authentication information record when the request to extend the term of validity of the authentication information is received, and judge whether the extension request was made within the term of validity of the authentication information (¶¶ 0068, 0073, 0092, and 0096); and an

Art Unit: 3621

authentication information updating section (“license information management unit 48a”) configured to extend the term of validity of the authentication information when the authentication information was created by the service providing apparatus and the extension request was made within the term of validity of the authentication information (§ 0092).

21. Ooho does not directly disclose authentication information created by the service providing apparatus; an identifier included in the authentication information; a processor configured to compare a stored number of times the term of validity of the authentication information has been extended against a threshold value; and an authentication information updating section configured to extend the term of validity of the authentication information when the stored number of times the term of validity of the authentication information has been extended is less than the threshold value.

22. Aldis teaches authentication information created by a service providing apparatus (§§ 0058+, “license creation” by license clearinghouse); and an identifier included in the authentication information (§§ 0098+, “license ID”).

23. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the ability to create authentication information that includes an identifier of Aldis’ clearinghouse into the device of Ooho that judges whether data was created by the device by referring to an identifier within the data since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.



Art Unit: 3621

24. Additionally, Tohyama teaches a processor configured to compare a stored number of times a license has been extended against a threshold value and to extend the license when the stored number of times the license has been extended is less than the threshold value (¶¶ 0053, 0097- 0104, and figs. 4, 5, and 10 with associated text).

25. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to apply the teachings of Tohyama to the system and process of extending the term of validity of the authentication information of Ooho. One would have been motivated to do so because this would prevent the term of validity of the authentication information from being extended beyond a desired number of times.

***Regarding Claims 2-10***

26. The combination of Ooho, Aldis, and Tohyama discloses the limitations of claim 1, as described above. The combination of Ooho, Aldis, and Tohyama, further, discloses the following limitations:

27. Claim 2: The service providing apparatus as claimed in claim 1, wherein said authentication information managing section is configured to manage the authentication information, information related to a request source which makes the extension request to extend the term of validity of the authentication information, and an authority to extend the term of validity of the authentication information (Ooho, ¶¶ 0061, 0067, and 0068);

28. Claim 3: The service providing apparatus as claimed in claim 1, wherein said authentication information managing section is configured to manage, in a related manner, the authentication information, information related to a request source which made a creating request

Art Unit: 3621

to create the authentication information, information related to a request source which makes the extension request to extend the term of validity of the authentication information, and an authority to extend the term of validity of the authentication information (Ooho, ¶¶ 0049, 0061, 0067, and 0068);

29. Claim 4: The service providing apparatus as claimed in claim 1, wherein said authentication information updating section is configured to judge whether a request source which made the extension request to extend the term of validity of the authentication information has an authority to extend the term of validity, and extends the term of validity of the authentication information when it is judged that the request source has the authority to extend the term of validity (Ooho, ¶¶ 0049, 0061, 0067, 0068, and 0092);

30. Claim 5: The service providing apparatus as claimed in claim 1, wherein said authentication information updating section is configured to extend the term of validity of the authentication information when it is judged that the request source has the authority to extend the term of validity, create new authentication information including the extended term of validity, and delete the old authentication information (Ooho, ¶¶ 0049, 0061, 0067, 0068, 0092, and 0133; and Aldis, fig. 11 with associated text);

31. Claim 6: The service providing apparatus as claimed in claim 1, wherein said authentication information managing section is configured to manage the authentication information and an extended term of validity of the authentication information in a related manner (Ooho, ¶ 0093);

32. Claim 7: The service providing apparatus as claimed in claim 1, wherein said authentication information managing section is configured to manage the authentication

Art Unit: 3621

information and a number of times the term of validity of the authentication information is extended in a related manner (Aldis, abstract; and ¶¶ 0016 and 0020);

33. Claim 8: The service providing apparatus as claimed in claim 5, further comprising: an extension response sending section configured to send an extension response including an identifier for identifying the newly created authentication information having the term of validity extended by said authentication information updating section (Ooho, ¶ 0041; and fig. 1 with associated text);

34. Claim 9: The service providing apparatus as claimed in claim 1, further comprising: a monitoring section configured to monitor the term of validity of the authentication information (Ooho, ¶ 0063);

35. Claim 10: The service providing apparatus as claimed in claim 1, further comprising: a notifying section configured to transmit information related to the term of validity of the authentication information to a request source which made a creating request to create the authentication information (Ooho, ¶ 0064).

***Regarding Claims 11-21***

36. These claims are understood by the Examiner to be of substantially the same subject matter as claims 1-10. Accordingly, claims 11-21 are rejected in substantially the same manner as claims 1-10. If in response to this action the Applicants disagree that the claims are of substantially the same subject matter, and provide evidence that they are of patentably distinct subject matter, the Examiner may withdraw this rejection under 35 U.S.C. §103 and alternatively impose a restriction requirement.

***Application of the Prior Art***

37. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

***Claim Interpretation***

38. The Examiner finds that because the examined claims recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because the examined claims fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that all examined claims (*i.e.* claims 1-21) do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

39. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.<sup>3</sup> Additionally, these definitions are only a guide to claim

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<sup>3</sup> While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

Art Unit: 3621

terminology since claim terms must be interpreted in context of the surrounding claim language.

Finally, the following list is not intended to be exhaustive in any way:

- a. ***processor*** “(2) (software) A computer program that includes the compiling, assembling, translating, and related functions for a specific programming language, for example, Cobol processor, Fortran processor.” IEEE 100 The Authoritative Dictionary of IEEE Standards Terms, 7<sup>th</sup> Edition, IEEE, Inc., New York, NY, Dec. 2000.

### ***Response to Arguments***

40. Applicants’ arguments with respect to claims 1, 11, and 21 have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

41. Applicants’ 09 Mar Amendments necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

42. Because this application is now final, Applicants are reminded of the USPTO’s after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a

Art Unit: 3621

claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112, 1<sup>st</sup> paragraph written description and enablement, §112, 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103, prior art).

Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

43. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

44. The prior art made of record and not relied upon is considered pertinent to Applicants’ disclosure (see attached form PTO-892).

45. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s supervisor, Andrew Fischer can be reached at (571) 272-6779.

Art Unit: 3621

46. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

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May 18, 2009

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